

No. 4105.

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IN THE  
**United States Circuit Court of Appeals**  
FOR THE NINTH CIRCUIT.

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ELOESSER-HEYNEMANN COMPANY,  
a Corporation,

*Appellant,*

VS.

KUH BROS., a Corporation,

*Appellee.*

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**BRIEF ON BEHALF OF PLAINTIFF-APPELLANT**

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NICHOLAS A. ACKER,  
*Solicitor and Counsel for Appellant.*

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**FILED**

**FEB 1 8 1924**

**F. D. MONDIN, CLERK**



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**BRIEF ON BEHALF OF PLAINTIFF-APPELLANT**

The present case comes before this Honorable Court on appeal from the final order and decision of the United States District Court for the Northern District of California, Second Division, filed and entered on the 7th day of April, 1923, adjudging the Letters Patent No. 56,450 in suit to be invalid.

The letters patent in suit were issued under date of Oct. 26th, 1920, to J. Miller and D. Macowsky on application filed May 7, 1917, for a design invention relating to what is known as child's rompers.

The Bill of Complaint is in the ordinary form in equity charging infringement of the design letters patent, praying for an injunction, and for an accounting.

By its answer the defendant below—appellee herein—challenged the validity of the design letters patent in suit and denied infringement. The case was tried in open court before District Judge George M. Bourquin, after which the court rendered and filed its opinion (Record pp. 18-21), adjudging the letters patent invalid on the ground of anticipation, and ordered a dismissal of the suit.

The assignment of errors (Record pp. 134-136), although nine in number, resolve themselves to two general errors, viz.:

(a) Error in holding invalidity of the letters patent in suit;

(b) Error in holding non-infringement.

Before giving consideration to the merits of the present appeal we desire to direct the Court's attention to two typographical errors occurring in the printed record. The first relates to the second assignment of errors (Record p. 135), wherein the word "not" appears in the third line of the assignment of errors and before the word "ordering". This word should be canceled. Our copy of the assignment of errors as filed with the lower court does not disclose this word, and the appearance thereof in the printed record is evidently a typographical error.

The second error, probably an immaterial one, is in connection with witness Garfinkel appearing as a witness on behalf of the "plaintiff" (Record p. 71). Witness Garfinkel appeared on behalf of defendant, not for the plaintiff.

## STATEMENT OF FACTS.

Briefly stated the facts of the present case are as follows:

Plaintiff-appellant and defendant-appellee are each located and doing business in the City and County of San Francisco, as manufacturers of garments, and plaintiff-appellant is owner by due assignment of all right, title and interest in and to United States Letters Patent No. 56,450 granted Miller and Macowsky under date of October 26th, 1920, on application filed in the United States Patent Office under date of May 7th, 1919.

Prior to obtaining patent protection by letters patent for the design invention herein involved, and within a period of less than two years before the filing of their application for letters patent thereon, the patentees, Miller and Macowsky, as manufacturers of children's garments, then located and doing business in the City and County of San Francisco, California, commenced the manufacture of the design garment of the letters patent involved herein. After the manufacture of such garment, one H. Garfinkle, a manufacturer of children's clothing, also located in San Francisco, California, doing business under the trade name "California Art Works", obtained one of the design garments manufactured by Miller and Macowsky. This garment the said Garfinkle copied and proceeded with the manufacture and sale of the same to the trade. On notice from Miller and Macowsky that the garment was a design invention for which they had then pending an application for letters patent thereon, the

said Garfinkle recognized the just claim of the inventors Miller and Macowsky and discontinued the manufacture and sale of said garment.

Shortly after the manufacture and sale by H. Garfinkle of the design garment invention in suit, Eloesser-Heynemann Company, plaintiff-appellant, also Kuh Brothers, defendant-appellee herein, commenced the manufacture and sale to the trade of the said garment. After issuance of the letters patent in suit each party was duly and promptly notified by the patentees, Miller and Macowsky, that the play suit garment being manufactured and sold by their houses constituted an infringement of the design invention one-piece play suit covered by Design Letters Patent No. 56,450 involved herein. As a result of such notification as to infringement, Eloesser-Heynemann Company, recognizing the justice as to the claim of Miller and Macowsky, took a license from the said patentees under a royalty agreement and continued with the manufacture and sale of such garments. This license at a subsequent period ripened into an assignment of the letters patent and the invention covered thereby unto said company, so that Eloesser-Heynemann Company acquired all right, title and interest in and to said letters patent and the invention covered thereby. Kuh Brothers, defendant-appellee, while not taking a written license from the patentees, Miller and Macowsky, entered into an agreement with said patentees to discontinue the manufacture and sale of its alleged infringing garment provided permission was given to dispose of the stock of the alleged infringing garments then on hand. Such permission was granted by the

patentees, Miller and Macowsky. However, Kuh Brothers did not keep faith with the patentees, but immediately on the disposal of the stock of the alleged infringing garments then on hand proceeded to place upon the market a second garment, in all respects, so far as relates to configuration, ornamentation, outline and appearance, substantially the same as their first manufactured and sold garment, and as to which they agreed to discontinue the manufacture thereof provided permission was granted to them to dispose of the stock then on hand.

The second garment manufactured by Kuh Brothers for sale to take the place of its first claimed infringing garment was disclosed by said Kuh Brothers to Mr. Eloesser, one of the members of the Eloesser-Heynemann Company, and after an examination thereof he, the said Eloesser, at once notified Kuh Brothers that, in his opinion, the said second garment was as much an infringement of the design letters patent involved herein as the first garment.

After Eloesser-Heynemann Company, plaintiff-appellant, acquired title to the letters patent in suit, various manufacturers of play suit garments located in San Francisco, California, commenced the manufacture and sale of one-piece play suits of substantially the same character as the invention of the design letters patent in suit. These manufacturers on notification as to infringement, gave recognition to the letters patent in suit and discontinued the manufacture of the claimed infringing garments, so that at the time of the commencement of the present action for infringe-

ment Kuh Brothers, defendant-appellee, constituted the only manufacturer refusing to discontinue the claimed infringing act.

Suit for infringement was instituted on the 17th day of May, 1921, but owing to the congested condition of the lower court relative to trial of cases pending, final hearing was not obtained until late in the month of March, 1923.

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### STATEMENT OF INVENTION.

The letters patent in suit, No. 56,450, appear as Plaintiff's Exhibit 1.

The letters patent were duly transferred by an assignment in writing unto Eloesser-Heynemann Co., plaintiff-appellant, and the assignment appears as Plaintiff's Exhibit 2.

For convenience of the Court the letters patent are here produced in full:





DESIGN.

J. MILLER AND D. MACOWSKY.

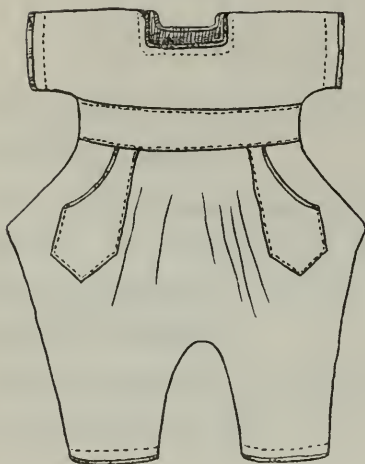
CHILD'S ROMPER.

APPLICATION FILED MAY 7, 1919.

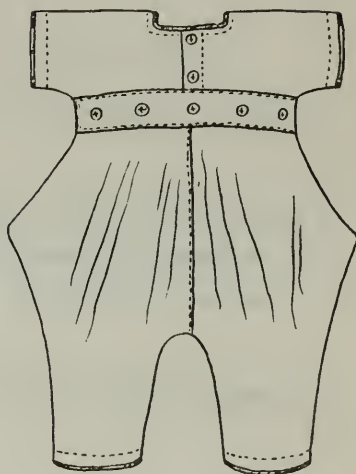
56,450.

Patented Oct. 26, 1920.

*Fig. 1.*



*Fig. 2.*



INVENTORS

*Julius Miller*  
*David Macowsky*

BY

*Strong & Townsend*  
ATTORNEYS

# UNITED STATES PATENT OFFICE.

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JULIUS MILLER AND DAVID MACOWSKY, OF  
SAN FRANCISCO, CALIFORNIA.

DESIGN FOR A CHILD'S ROMPER.

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56,450.

Patented Oct. 26, 1920.

Specification for Design.

Application filed May 7, 1919. Serial No. 295,489. Term of patent  
14 years.

*To all whom it may concern:*

Be it known that we, JULIUS MILLER and DAVID MACOWSKY, citizens of the United States, residing at the city and county of San Francisco and State of California, have invented a new, original, and ornamental Design for Children's Rompers, of which the following is a specification, reference being had to the accompanying drawing, forming part thereof.

Figure 1 is a view in front eleva-

tion of a child's romper showing our new design.

Fig. 2 is a view in rear elevation of the same.

We claim:

The ornamental design for a child's romper, as shown.

JULIUS MILLER.  
DAVID MACOWSKY.

Witnesses:

W. W. HEALEY,  
G. M. BALL.



As will be noted from an examination of the letters patent, the specification discloses a design for child's romper or play suit, and the same is illustrated in two views by the drawings, Fig. 1 being a front view of the child's romper or play suit and Fig. 2 a rear view of the garment. The invention is readily visualized by reference to the drawings illustrative thereof. The claim is in the usual form covering design inventions, being expressed "*The ornamental design for a child's romper, as shown.*" When reference is had to the two views of the drawings forming a part of Design Letters Patent No. 56,450, it is apparent that the design invention is pictured in general outline as a garment of a horizontal line from the end of one short sleeve across the shoulders to the end of the other, and notched or cut away intermediate to form what is disclosed in the illustration as a square neck opening. A belt feature is arranged below the arm pits which may or may not be of a detachable character, and when viewed from the rear there is disclosed associated with the belt feature, buttons. The waist of the garment, which constitutes a continuation and a permanent portion of the trouser portion of the romper or play suit, is such as to give a short-waisted line appearance, while the trouser section of the garment is of an outline to produce what has been termed in the present case "pegged" top long trousers. There are buttons at the back of the waist and belt of the garment, and ornamentation relative to the neck opening and sleeves.

It will be noted that the Design Letters Patent No. 56,450 is for a one-piece romper or play suit, the expression one-piece being employed in contradistinc-

tion to play suits or rompers composed of upper and lower separable parts. The first garment manufactured and sold by defendant-appellee appears in the record as Plaintiff's Ex. 4 and the garment now being manufactured and sold by the defendant-appellee appears as Plaintiff's Ex. 5, while the garment manufactured and sold by the plaintiff-appellant appears as Ex. 3.

Comparing Plaintiff's Ex. 4, the first garment manufactured and sold by the defendant-appellee, with the invention disclosed by the specification and drawings of the Design Letters Patent No. 56,450, it will be observed that said garment in all its details conforms strictly to the invention as illustrated, described and covered by said Design Letters Patent No. 56,450. An examination of Plaintiff's Ex. 5, comparison thereof with the invention of Design Letters Patent No. 56,450, discloses every element of the design letters patent to be embodied in said Ex. 5.

The lower court in its decision gave to the invention of the design letters patent in suit all of the attributes necessary to sustain a design invention, stating that there was

"no doubt of the oddity, quaintness and simple artistic merit of plaintiff's design, nor of the utility (sometimes of account even in design patents), attractiveness, popularity and wide use of its garments."

No higher tribute in support of design invention is possible than that given by the lower court to the design invention in suit as above expressed, being further advised by the lower court that

“Defendant’s garment in entirety is plaintiff’s in appearance and impression”,

and if the court had not found, as it did, want of invention, a decision of infringement of said Design Letters Patent No. 56,450 must of necessity have followed.

The action in the lower court was commenced under Section 4929 of the Revised Statutes, as amended, and which reads as follows:

“Any person who has invented any new, original and ornamental design for an article of manufacture, not known or used by others in this country before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country before his invention thereof, or more than two years prior to his application and not in public use or on sale in this country for more than two years prior to his application unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceedings had, the same as in cases of inventions or discoveries covered by Sec. 4886, obtain a patent therefor.”

We have pointed out as to the finding of the lower court relative to oddity, quaintness, artistic merit, utility, attractiveness, popularity and wide use of garments manufactured and sold by the plaintiff-appellant under the design letters patent in suit, and equally so have called attention to the finding of the court as to the defendant-appellee’s garment in its entirety as to appearance and impression being that of the plaintiff’s design garment, and it only remains whether or not the patentees of Design Letters Patent No.

56,450 invented a new, original and ornamental design for an article of manufacture. It is hardly necessary to go into the question as to whether or not such a garment was "known or used by others in this country" before their discovery, for the record in this case is absolutely silent as to such a design garment ever having been known or used by others in this country prior to the invention thereof by the patentees of Design Letters Patent No. 56,450, nor is there any evidence contained in this record as to any such garment having been "in public use or on sale in this country for more than two years prior" to applicants' application for the design letters patent in suit, and, equally so, it has not been proven under the record in this case that the said invention had "been abandoned". The sole question as we view it in connection with the present appeal is whether or not the invention of the letters patent in suit has been anticipated and by reason thereof the letters patent invalid. Want of invention does not enter into the present case except in so far as want of invention is negated by prior publications. There is not and cannot be, in view of the decisions to which we shall later direct attention, any question as to a child's romper or play suit constituting an article of manufacture under and within which the meaning of Section 4929 of the Revised Statutes, for such question has been decided affirmatively by this court.

### ALLEGED ANTICIPATION.

There is no general rule applicable to the question of anticipation, for it is about as difficult to state a



general rule of anticipation as it is to define invention. The difficulty with all general rules, or attempts at general rules, is that when we come to apply them to a specific case there are so many variations from the supposed condition upon which the general rule is predicated that application is difficult, if not impossible. There is no question, however, that in order to establish anticipation, that which is alleged to anticipate must show or disclose the invention at issue to such an extent as to enable one to produce from the alleged anticipatory matter and by following the lines and disclosure thereof that which it seeks to anticipate. Where the matter sought to be anticipated relates to a design, such anticipatory matter must disclose the design in its entirety. In applying the rule of anticipation to the design invention at issue we are not permitted to take one feature or element of the design from one prior publication or patent, another element from another and a third from still another and from the three or more prior patents or publications build up or construct an anticipation of the design invention. The design as a whole must be present in some one of the alleged anticipatory publications or prior patents, for the single claim contained in the letters patent at issue is the full equivalent of a combination claim under a mechanical patent. No claim is made that any one element of the design invention constitutes the sole novelty thereof and being for a combination it is presumed that each and every element which goes to make up the design invention as a whole is old in the art. The present invention re-

sides in the combining of these various old elements or features into a unitary or single design.

In support of the defense of anticipation the defendant-appellee herein introduced in evidence the following publications and prior issued letters patent:

Publication entitled "The Dutch Twins," copyrighted in 1911, Defendant's Ex. "E";

United States Design Letters Patent No. 51,674, granted Jan. 8, 1918, to Simon E. Davis, Defendant's Ex. "F";

United States Design Letters Patent No. 52,720 of Nov. 19, 1918, issued to Wm. I. Zidell, Defendant's Ex. "G";

United States Design Letters Patent No. 54,809, granted March 23, 1920, to Wm. I. Zidell, Defendant's Ex. "H";

United States Design Letters Patent No. 1,255,491, issued to Mary T. Verde, Defendant's Ex. "I";

United States Design Letters Patent No. 47,337, granted June 15, 1915, to G. Averill, entitled "Design for Doll," Defendant's Ex. "J".

Each of these letters patent was testified to by plaintiff's witness, Herbert Eloesser, and in his testimony the witness very fully pointed out wherein the inventions of the said publication and letters patent failed to disclose the design invention of the letters patent in suit, the testimony of the witness appearing between pages 128 and 129 of the record. However, analyzing these references a little more closely than was done by witness Eloesser, we will first give consideration to Ex. "E", the same being a publication entitled "The Dutch Twins". This publication does not disclose, by illustrations or otherwise, a one-piece romper or play suit, the garment portrayed by the illustrations appear-

ing in the publication disclosing a typical Dutch clothing outfit for a child, and which consist of three distinct and separable elements, viz., trousers, a shirt, and a waistcoat which is put on over the shirt. The trousers are of the type known as bloomer or balloon trousers, being exceedingly full, and the bottom of the leg sections bound to the ankle of the wearer by tape or elastic. This is more clearly shown on the first, second and fifth unnumbered pages of the publication and in connection with the picture illustrations opposite pages 11, 14, on page 20, opposite page 30, on pages 32, 44, opposite pages 52, 57, 60, on pages 71, 75, 77, opposite page 87, on page 127, opposite page 139, and on page 147 of the said publication. The trouser element is not shaped or designed to conform to the design outline of the trouser section of the one-piece design garment of the letters patent in suit and which element of the design letters patent comprises a long-legged, open bottomed trouser of pegged-top style. Under the design of the letters patent in suit, the trouser element constitutes an integral portion of the waist of the one-piece child romper or play suit, whereas in the Dutch Twins publication, the illustration of the clothing applied to the child, the waist and trousers represent separable elements. The waist of the suit illustrated in the book "The Dutch Twins" (Ex. "E") has not the shape or appearance of the waist element of the one-piece design invention of the letters patent involved herein. The illustrations of the said publication to which attention has been directed merely disclose that the trousers are buttoned to a waist fitted over the child and there is

not in the plaintiff's design invention that loose, full balloon appearance present in the cuts appearing in the publication. No one could possibly mistake the clothing appearing in connection with the illustration of the said publication and as applied to a boy, for the design garment of the letters patent in the suit. There is not that similarity of appearance which would deceive an ordinary purchaser in accepting one garment under the belief that he was securing the other garment. In other words, the test of infringement of design letters patent does not apply as between the pictorial displays of the said publication and the one-piece design garment of the letters patent under consideration. We do not believe it can be said as between the one-piece play suit design invention of said letters patent and the garment display of the publication, that an ordinary observer, giving such attention as a purchaser usually gives, would be induced to purchase one, supposing it to be the other. If this be true, then there can be no anticipation of the design invention of the letters patent by reason of the earlier publication, defendant's Ex. "E". As stated, the illustrations contained in the said publication are those of the typical dress of the Hollandese, and which, as we know, is entirely different in appearance and general arrangement from the type of garment worn by the American child.

The lower court held the letters patent in suit to be anticipated on the ground that

"Plaintiff's garment is none other than the Hollandese boy's costume from time immemorial known everywhere from use in original or modi-

fied forms, from paintings, engravings, illustrations and literature, to an extent warranting judicial notice."

We have not before us the Hollandese boy's costume which the Court had in mind, nor have we before us the paintings, engravings, illustrations and literature to which the Court referred in its decision. We must assume, however, that what the Court had in mind when making reference to the Hollandese boy's costume comprised costumes of the type represented by the picture illustrations to which we have directed attention relative to "The Dutch Twins" publication, (Defendant's Ex. "E"), for in his decision the Judge states that if he is not warranted in taking judicial notice of the matter mentioned, then it was only necessary to advert to defendant's evidence, viz:

"illustrations in Perkins' 'The Dutch Twins', published not later than 1915 by 'The Riverside Press', and various garments and designs of date not later, especially Averill's Design Patent No. 47,447."

We submit that the publication "The Dutch Twins", Def. Ex. "E", does not disclose the one-piece play garment design of the letters patent in suit.

"The Dutch Twins" publication does not disclose a one-piece design play suit, but clearly illustrates three separate elements of clothing. It does not disclose by illustration the pegged shaped trousers corresponding to the trousers section of the one-piece play suit design of the letters patent in suit. On the contrary, the illustrations of the Dutch Twin publication disclose, as above stated, garments comprising three distinct



and separate elements, one element being the trousers portion of the full-cut bloomer type drawn in at the ankles, but without peg shape; an independent sleeveless body closed down the front instead of closed down the back, and a separate shirt worn under the bodice having sleeves extending through the sleeve-holes of the bodice. In every respect the illustrations of this publication disclose garments entirely foreign to the one-piece design garment of the letters patent in suit.

Judge Bourquin in his decision expresses the opinion that two garments are the same, if when *draped upon the person of a wearer* they are substantially alike in appearance, and that in such case they are of like design, however they may vary in pattern, details of curvature, and angularity. We submit that it is not a question whether two garments may be draped upon the person of a wearer to give or produce a given appearance, but the true test is whether two such garments placed side by side present the same appearance to the eye of an ordinary observer, when giving such attention as a purchaser usually gives, and even then the resemblance between the two garments when thus viewed by an ordinary observer must be such as would induce him to purchase one supposing it to be the other. To a purchaser, the comparison is made between the garments themselves as they appear in the show windows and on the counters of stores and not as to how the garments may be draped upon the person of a wearer. The three-piece garment disclosed in the illustrations of defendant's Ex. "E" "The Dutch Twins" may possibly be so arranged and draped upon the person of the wearer as to give the appearance

of the design garment of the letters patent in suit when applied to the person of the wearer, but if such draping and arrangement be possible for the three-piece garment illustrations of "The Dutch Twins" publication to approximate in appearance the design of the one-piece garment of the letters patent in suit, such could not properly be held or construed to be an anticipation of the patented design invention. It would be more in the nature of an attempt to anticipate by building up piece meal from the prior art an anticipatory structure. An ordinary purchaser exercising ordinary and reasonable care would not be led into purchasing a three-piece garment like the ones illustrated in defendant's publication Ex. "E", believing he was purchasing the design garment of the letters patent in suit. The two garments are absolutely different in appearance and unquestionably this publication was well known to the Examiners in the Patent Office when granting the letters patent in suit and, the issuance of the letters patent is *prima facie* evidence as to novelty and invention over the pictures of the said publication. For instance, examining the picture opposite page 30 of the publication, we are given a rear view of the Dutch costume. Comparing this illustration with the rear view illustration of the design garment of the letters patent, Fig. 2 of the drawings, we find a total absence of the design of said letters patent present in the illustration of the publication. In fact, this dissimilarity is marked not only as to the drawn-in appearance of the trousers at the bottom over the open-bottomed ends of the trousers section of plaintiff's one-

piece design garment, but equally so as to the entire dissimilarity regarding the back of the waist and the belt effect of the design garment of the letters patent. In seeking to anticipate the design invention of the letters patent in suit, that which is offered in anticipation must disclose the design invention in its entirety. Such is not the case with the pictorial illustration of "The Dutch Twins."

Defendant's Ex. "F", Design Patent No. 51,674 illustrates a garment so foreign in appearance, configuration and general outline to the design one-piece garment invention of the letters patent in suit as to hardly justify comment. Certainly no ordinary observer, giving such attention as a purchaser usually gives, would be deceived into buying a garment conforming to Design Letters Patent No. 51,674, Defendant's Ex. "F", under the belief that he was purchasing the one-piece garment of the design letters patent in suit. There is no resemblance between the two design garments and certainly the manufacture and sale of the design garment of Letters Patent No. 51,674 would not constitute an infringement of the design garment of Letters Patent No. 56,450 in suit. As well stated by witness Eloesser (Record p. 129):

"Exhibit 'F' is a boy's style play suit, which was the only available type of play suit on the market at the time our design was introduced. It is a straight garment with a very low waist and has none of the appearance of the peg top style and high waist and other features of our design. I cannot imagine a design more foreign to the design of the letters patent in suit than the one set forth and illustrated by Design Letters Patent #51,674, Defendant's Ex. 'F'."



Defendant's Ex. "H", Design Letters Patent No. 54,809 is a garment designed for very small children ranging in age from eighteen months to approximately two and one-half years, being more of the creeper type garment. The only possible similarity between the said design garment and the design invention of the letters patent in suit may be said to reside in the upper portion of each garment wherein is disclosed the horizontal line effect incident to the end of one short sleeve to the other. The bottom and waist elements of the two garments are entirely dissimilar. In fact, the one-piece play garment of the letters patent in suit bears no resemblance to the design garment of Letters Patent No. 54,809. At best, said patent No. 54,809 can only be termed a short-legged, romper or creeper garment in contradistinction to the long-legged one-piece design garment of the letters patent in suit. No one could possibly be misled into purchasing a garment conforming to Design Letters Patent No. 54,809 under the belief that he was purchasing the design garment of the letters patent in suit. There is not that resemblance between the two garments as would deceive an ordinary observer and such an observer could not possibly be led to purchase one garment supposing it to be the other garment and the manufacture at this date of the design garment of Letters Patent No. 54,809 would not constitute an infringement of the design garment of Letters Patent No. 56,450. That which does not infringe if later, does not anticipate if earlier.

Defendant's Ex. "G", Design Letters Patent No. 52,720, is the same as the design garment of Letters

Patent No. 54,809, Defendant's Ex. "H", the only difference as to appearance being that the design garment of Letters Patent No. 52,720 is highly ornamented, whereas the ornamentation of said letters patent is absent in the design garment of Letters Patent No. 54,809. The design of each letters patent is the same and, as hereinafter pointed out, this Court held the two designs to be the same and Design Letters Patent No. 54,809 to be invalid in view of the previous Design Letters Patent No. 52,720 granted to the same party.

Whatever differences we have pointed out between the design invention of Letters Patent No. 54,809 and the design of the letters patent in suit, applies with full force relative to Design Patent No. 52,720 and the design garment of the letters patent in suit.

As well stated by witness Eloesser, referring to defendant's Ex. "H":

"This is the style of romper that was put on the market by Patsy. It has not any legs, it has an opening for the feet to go through with a cuff effect. It is not a play suit or a long-legged affair in any sense of the word. Ex. "G" partakes of the same general expression as Ex. "H" except that it has a little different ornamentation on it."

In the comment thus made relative to Defendant's Exs. "G" and "H," witness Eloesser is supported by this court in holding the two design inventions of the mentioned Exs. to be the same.

Defendant's Ex. "I," United States Letters Patent No. 1,255,491, discloses and claims a child's garment provided with a body portion and a flaring skirt por-

tion. It has a closed front and a divided back, but we fail to note any similarity between this skirt garment and the design one-piece play suit of the letters patent in suit and we may dispose of this by reference in the testimony of witness Eloesser, wherein he states with reference to said Ex. "I":

"That seems to be a one-piece garment, with a skirt; it does not seem to have any type of legs at all, it is quite different; I think the fact that it has a skirt and hasn't any legs to it would make it so different that we need consider it no further."

The entire arrangement of the garment, its manner of construction as described in the specification of the patent and illustrated in the drawings, is so remote in every particular from that of the design one-piece garment of the letters patent in suit, that we cannot believe that defendant's counsel seriously contends that said letters patent Ex. "I" anticipates the design invention of the letters patent in suit. Fig. 3 of the drawings which accompany the said letters patent clearly discloses that the invention relates solely to the formation of a pattern which, when folded on proper lines, is adapted to produce a child's garment of the romper type and the type of romper is, as well expressed in the statement of invention, between lines 9-21, page 1 of the specification

"embodied in a garment adapted to be conveniently applied and removed, to be readily washed and ironed, and to form openings for the legs of the wearer and an intermediate diaper cover when the garment is secured in place, the margins of said leg openings and intermediate portions of the diaper cover being substantially flush with

other so that the skirt presents a substantially continuous bottom edge when the garment is in use."

Undoubtedly when the garment is applied to the person of the wearer there is produced a skirt garment, but not in any sense a trouser-type, one-piece play suit.

Design Letters Patent No. 47,447, Defendant's Ex. "J," is a design for a doll, not for a one-piece garment adapted to be applied to the person of a wearer. In every respect it differs radically from the design garment of the letters patent in suit. The shape given to that portion of the doll below the waist does not present the design given to the trouser element of the one-piece play suit of Design Letters Patent No. 56,450 in question and it cannot be said that there is any similarity between the upper or waist portion of the doll and the upper or waist element of the design letters patent in suit. There is no proof in the present case of a play garment ever having been constructed in accordance with the design of the doll illustrated in Letters Patent No. 47,447, Defendant's Ex. "J," and certainly no such garment has ever been manufactured and applied to the person of a wearer. No one could possibly be deceived into purchasing the design doll of Letters Patent No. 47,447 under the belief that he was purchasing or acquiring the one-piece design garment of the letters patent in suit. Defendant's Ex. "J," not being a one-piece garment adapted to be secured to the person of a wearer, it cannot serve to anticipate a one-piece design garment adapted to be applied to the person of a wearer. The said Ex. "J" does not illustrate a garment of manufacture in any particular.

At best, the said exhibit can only be said to illustrate a dressed doll having the appearance of a two-piece garment with a waistcoat effect and with the further appearance that the waistcoat is laced down the front. The entire proportion of the doll differs radically from the proportions of design garment of the letters patent in suit. Relative to this exhibit, witness Eloesser states:

“It don’t look as though it would be a practical design of a garment to be used. The proportions are quite different, the small waist on the doll is differently proportioned from what our design shows, also down at the hips.”

It is impossible to picture a child dressed in a garment of the outline and configuration of the design doll of Defendant’s Ex. “J,” presenting the appearance of a child when dressed in the one-piece play suit design garment of the letters patent in suit, and if it be possible to produce a garment conforming to the outline and configuration of the design doll of Letters Patent No. 47,447 it is safe to say that such garment when placed in a show or display window side by side with the one-piece design garment of the letters patent in suit would not induce an ordinary purchaser into buying the same believing he was buying the design garment of the letters patent in suit.

The foregoing letters patent and publications constitute the full list of exhibit publications introduced in evidence on behalf of defendant-appellee, in support of the defense of anticipation of the design invention of the letters patent in suit. Of these letters patent Judge Bourquin, in his decision holding the letters

patent in suit to be invalid, gave consideration to only Defendant's Ex. "E," publication entitled "The Dutch Twins" and to Defendant's Ex. "J," Design Letters Patent No. 47,447 for a doll, and on these two exhibits held the design letters patent to be anticipated.

Where anticipation or want of invention is set up as a defense on the part of the defendant, the burden of proof to make good such defense is upon the party alleging the same and every reasonable doubt, in view of the grant of letters patent, should be resolved against such party.

We submit that the prior art as above set forth and analyzed does not disclose anticipation or want of invention of the one-piece design garment of the letters patent in suit beyond a reasonable doubt, and that the defendant has not sustained the burden placed upon it relative to such a defense, for, as well stated in the case of *Cantrell vs. Wallick*, 117 U. S. 689:

"The burden of proof is upon the defendant to establish this defense. For the grant of letters patent is *prima facie* evidence that the patentee is the first inventor of the device described in the letters patent and of its novelty."

The court says further:

"Not only is the burden of proof to make good this defense upon the party setting it up, but it has been held that every reasonable doubt should be resolved against him,"

citing:

*Coffin vs. Ogden*, 18 Wall 120;  
*Washburn vs. Gould*, 3 Story 122.



This rule has been followed in the various Circuits, and this Circuit adhered to it in the following cases:

*San Francisco Cornice Co. vs. Beyle*, 195 Fed. 516;  
*Consolidated Contract Co. vs. Hassam Paving Co.*, 227 Fed. 436;  
*Schumacher vs. Buttonlath Manufacturing Co.*, 292 Fed. 522.

With all due deference to the opinion of Judge Bourquin, we submit that the prior letters patent and publications set up in support of the defense of anticipation fail to disclose the design invention of letters patent in suit and do not, therefore, constitute an anticipation thereof, for garments constructed under either of the said letters patent and publication exhibits if placed on the market at the present time would not constitute an infringement of Design Letters Patent No. 56,450, for an ordinary observer giving the attention that a purchaser usually gives, would not be induced into buying a garment manufactured in accordance with the disclosures of said publication and prior patents believing it to be the design one-piece play suit of Design Letters Patent No. 56,450 in suit.

### INFRINGEMENT.

Seemingly, the decision of Judge Bourquin indicates the defendant's garment to be the same as the one-piece garment of the letters patent in suit, the words employed in the decision being:

"Defendant's garment in entirety is plaintiff's in

appearance and impression, but in view of the prior state of the art, in the latter is no invention and in the former no infringement."

This is a clear expression on the part of the trial judge that if the invention of the letters patent in suit had not been anticipated by reason of the prior state of the art, infringement would have been held.

The record in the present case clearly discloses the defendant's garment to have embodied therein the invention of the design letters patent owned and controlled by the plaintiff-appellant. Witness Eloesser (Record p. 36) when called upon to make comparison between the defendant's garment and the plaintiff's garment manufactured under and accordance with the design letters patent in suit, states that Plaintiff's Ex. 3

"is a one-piece peg-top, long leg play suit, with short outstanding sleeves, and a high waist effect, and the effect of a belt joining the waist onto the trousers portion. I find on the back that the long legged peg-top effect and short sleeves are still in evidence, with the high waist, and opening down the back, and having a drop seat. This garment, # 4 (defendant's first garment, plaintiff's Ex. 4), I find, is also a one-piece long legged peg-top play suit, with short outstanding sleeves; it also has a high waist effect, and the effect of a belt joining the waist to the trousers portion. It also has in the back the same high waist effect, the long peg-top trousers and the drop seat, and it opens down the back, and I consider that the garments are practically identical in design."

and (Record p. 37) the witness testified when making comparison between Plaintiff's Ex. 5 (Defendant's second garment) and Plaintiff's Ex. 3:



"I have already examined and described Ex. 3. Plaintiff's Ex. 5 I find has the same peg-top long leg trousers portion, has the appearance of a high waist, and the effect of a belt, has square outstanding sleeves, and in the back I find that it has the same peg-top long leg trousers effect, the effect of a belt, it has a drop seat, it opens down the back, it has a square outstanding sleeve. These are the points of similarity. I find that the points of difference are that they have added a small red strip in the front, the same in the back, and I consider that in no way affects the design of the garment. I notice that the belt is not stitched down in front, but I consider that that is unimportant in the design."

The addition of the small red strip to the front and the back of the defendant's garment, Ex. 5, charged to be an infringement, does not change or vary the garment from the design invention of the one-piece play garment of Design Letters Patent No. 56,450 in suit. At best, such can only be held an additional ornament applied to the design garment of said letters patent.

The witness Eloesser was asked whether in his opinion the addition or absence of the colored strips which appear on the front and back of the garment, Ex. 5, made any difference as to the design of the play suit garment and in response testified (Record p. 38):

"I consider the design identical, and I think it would not change the design in the least if we took the red strip off of it."

Exhibit 6 is the identical one-piece play suit manufactured by plaintiff-appellant under Design Letters Patent No. 56,450, with the addition of the irregularly disposed red strips arranged on the front and back in

the manner in which they are disposed relative to the defendant's garment Ex. 5 and so applied that the same are readily removable. With the addition of these red strips garment Ex. 6 is not commercially distinguishable from Plaintiff-Appellant's Ex. 5 which is the claimed infringing garment. When the two strips are removed we have plaintiff-appellant's garment in accordance with the design letters patent in suit. (The front applied strip was removed during the course of the witness' testimony, but the back strip still appears in connection with said Ex. 6 and may be easily removed therefrom.) The addition or omission of said strips does not vary the design of the one-piece garment, for the design garment was made prior to placing the strips thereon and it is the same design garment whether the strips be added or omitted.

Miss Mae White, witness for the plaintiff, by occupation a buyer for the firm of Upright & Co. of Oakland, Calif., testified as to her familiarity with the one-piece play suits placed on the market by plaintiff and by the defendant and states (Record, p. 55) that Plaintiff's Ex. 3 and Plaintiff's Ex. 5 represent the play suits purchased by her for the firm of Upright & Co., and when asked the question

"From your experience in selling these children's play suits would, in your opinion, customers who came to purchase from your establishment play suits to match the plaintiff's design, if shown the defendant's design of play suit, believe that it was a designed garment similar to that of the plaintiff's?"

answered "They would."

and when asked whether, in her opinion, the fact that the play suit of Kuh Bros. disclosed the colored strips on the waist and on the sleeves, made it a different design garment from that of Eloesser-Heynemann Co., replied (Record p. 58) :

“No; the trimming would have nothing to do with it, they look alike.”

James Mullen, witness for the plaintiff, a merchant conducting a jobbing house of men's furnishing goods at Fresno, Calif., when questioned as to whether he had experienced any difficulty with reference to the sale of play suits within his territory by reason of the play suits manufactured, and sold, and placed on the market by Kuh Bros., testified that he had and (Record, p. 63) he gives the names of a series of merchants with whom he encountered this difficulty, and when asked to explain just what he meant by difficulty, stated :

“They could buy the Kuh garment considerably cheaper, and it takes the place of our garment.

Q. What do you mean by that ‘it takes the place of our garment’?

A. They make things so identical that they do not see the difference in it, and will accept it in place of the Kute Kut.”

“Kute Kut” is the trade name under which plaintiff's garment is sold on the market.

Paul Heynemann, witness for the plaintiff, testified (Record, p. 66) as to various stores visited by him and noting how the plaintiff's garments and the defendant's garments were displayed for sale in said stores, stating :

"Ordinarily, they are displayed by piling them on shelves; once in a while on counter display, with a suit on a model, and once in a while also in the windows on models, or draped over special racks.

Q. Is there any distinction made in the houses where you have noted the products of the defendant and the plaintiff on sale, as to how these goods are offered for sale, I mean kept separate and distinct?

A. No."

and further answering (Record p. 67) :

"There is no distinction. The garments of our manufacture and those of Kuh Bros. are piled together. According to my experience, the first one that happens to be on top is handed out to the customer, who comes in the store."

and when asked how the suits are usually designated to the trade, testified :

"They are designated as the peg-top child's garment, with long legs, high waist."

and that they are known as "one-piece garments," and when asked (Record p. 68) whether, as the head salesman for Eloesser-Heynemann Co., he had received any orders from outside territory wherein orders for play suit of Eloesser-Heynemann had been canceled by reason of the fact that the same garment manufactured by the Kuh Bros. could be purchased at a less price, testified that he had and further stated (Record p. 69) :

"In this particular case we received an order, or a copy of an order, in which certain items which had been ordered from us were scratched out, and there was a notation on the bottom by our salesman, Mr. Walburn, saying that those

items should be eliminated, because they could obtain for a less price, the same garment, and he mentioned the lot and price of Kuh Bros. illustrating definitely that they could get the same garment for a less price, and, therefore, we should not ship those particular items."

The testimony of defendant's witness, Simon E. Davis, under cross-examination (Record pp. 93, 94 and 95) clearly indicates that he as an expert, relative to the manufacture of play suits, etc., considers the defendant's and the plaintiff's garment to be the same as to the design and shape thereof, and it is somewhat significant relative to the testimony of this witness that although he himself at one time made up on behalf of Levi Strauss & Co. patterns for a one-piece, long-legged, peg-top, short-waisted effect garment, and evidently intended on behalf of said company to place the same on the market, nevertheless, according to his testimony (Record p. 75) it was due to the letters patent in suit that he discontinued the idea of marketing such a design garment and abandoned the idea. Thus defendant's own witness and at the time of making up patterns for the manufacture of such a garment, being manager of Levi Strauss & Co., gave, by the abandonment of the idea of manufacturing such a garment, full recognition to the invention of the letters patent in suit. Defendant's witness, Miss L. B. Richards, employe of O'Connor-Moffatt & Co. of this city, testified as to her familiarity with the one-piece play suits manufactured and placed on the market by Eloesser-Heynemann Co. and Kuh Bros. and as to O'Connor-Moffatt Co. carrying and selling

the two garments and, in response to cross-questions (Record p. 99) testified that one garment sells as readily as the other. Although this witness is an expert, we submit that the entire testimony given by the witness clearly establishes the identity between the two garments in question.

### ATTITUDE OF DEFENDANT.

Under the evidence as presented by the record herein, the defendant is shown to be a deliberate and wilful infringer. According to the testimony of Mr. Louis Kuh, one of the members of defendant Kuh Bros., due notice was received by the defendant from the patentees, Miller and Macowsky, relative to claimed infringement of Design Letters Patent No. 56,450 in suit by the manufacture, distribution and sale of the one-piece design play suit garment, Defendant's Ex. 4, a similar garment appearing in evidence as Defendant's Ex. "P." Relative to this notice of infringement, the witness testified in response to following direct questions (Record pp. 103-105):

"Q. Now, Mr. Kuh, tell me about any dealings or negotiations you had with Miller & Macowsky before they turned over the patent to Eloesser-Heynemann Company.

A. Well, here was the dealings we had with Miller & Macowsky; one day we received letter from Miller & Macowsky that they had secured a patent on that garment we were manufacturing, that garment similar to the one being made by Eloesser-Heynemann Company, that garment you have over there. (Referring to Plaintiff's Ex. 3.)

Q. Is this the garment?

A. Yes, we made that up in various materials, including blue denim, khaki, etc.; we had been



making up that garment, we never knew that anybody had a patent on it, and one day we were notified—you have got the date of the letter there, I don't remember the date, but it was in 1921, that we were notified by Miller & Macowsky that they had a patent on that garment, and we were very much surprised at the same, and I went over to see Mr. Feisel, of the Baby Shop, who I knew was selling these garments, Mr. E. J. Feisel, who was the man that testified this morning, and they claimed that they had been making that garment the whole time, and that it was made by a man by the name of Garfinkel, and that Miller & Macowsky had got the garment from Garfinkel.

Q. I want to get your dealings with Miller & Macowsky.

A. Well, as I said before, they wrote us a letter that we were infringing, and account of bad feeling we had between the two firms we did not pay any attention to the letter, and then Mr. Macowsky 'phoned up one day that he wanted to see me; he came over, and my brother I. D. Kuh was present at the time, he said, 'Boys, I want to be friends with you,' he said, 'I wish you would stop manufacturing that garment.' So I said, 'All right, we will let up,' and we stopped manufacturing the garment, on the condition that we could sell what stock we had, and he said that would be perfectly satisfactory to him if we would stop manufacturing the garment altogether, and we promised to do so, so we did; so we started to sell the stock out that we had left.

Q. You did stop manufacturing?

A. We stopped manufacturing the garment as soon as we had this conversation with Mr. Macowsky, and that was satisfactory to him.

Q. He agreed that you could sell what you had on hand?

A. He agreed in the presence of my brother that we could sell the garments that we had on hand."

As to this first manufactured garment of the Defendant-Plaintiff's Ex. 4, Judge Bourquin states in his decision "Subsequent to the patent defendant manufactured an identical garment."

Naturally one would expect and look to the defendant to keep full faith with the patentees after having been accorded permission to dispose of the infringing garments then in stock, on condition that they discontinued from infringing thereafter. However, instead of so doing, the defendant after disposing of the garments then on hand and admitted to be an infringement, turned its efforts to manufacturing a garment substantially similar in all respects to its former garment. This is the one-piece play suit appearing in evidence as Plaintiff's Ex. 5. In shape, configuration, outline and general appearance, it is the plaintiff's patented design garment, modified only to the extent of a slight change in the shape of the neck opening and the placing of the red strips before referred to on the front and back of the garment; making the belt loose instead of fixed in appearance and placing the patch pocket on the inside, instead of on the outside of the garment. These slight changes do not take the new one-piece play garment of the defendant from within the protection of the patented design garment of the letters patent in suit, nor do they constitute such changes nor produce such a different design garment as would prevent an ordinary observer from purchasing said garment when desiring the design garment of the plaintiff. On the contrary, under the evidence in the present case an ordinary observer would be induced into purchasing one garment believing he was purchasing the other,



and, in fact, it is disclosed that merchants refused to purchase the plaintiff's design one-piece play garment due to the fact that they could obtain the same garment from the defendant for less money.

With the claimed changed garment before him, Judge Bourquin held "Defendant's garment in entirety is plaintiff's in appearance and impression."

It is somewhat interesting to note the manner in which the so-called changed garment was produced by the defendant. With full knowledge of the invention of the design letters patent in suit, knowing that the garment it had agreed to discontinue the manufacture of took well with the public and commanded a ready sale, the following steps, according to the testimony of Mr. Louis Kuh, were resorted to. *Not without full knowledge of the patent in suit*, as stated by counsel for defendant in his points and authorities filed with the lower court, but will full knowledge thereof.

Defendant carefully looked over and examined the various suits for children it then had in stock for one disclosing a trouser portion in resemblance of such section of the garment it had been making and another having an upper section similar to the upper portion of said garment. The result of this examination was the location of Defendant's Exs. "M" and "O." Neither of these garments conform to the one-piece design invention of the letters patent in suit. Ex. "M" is a creeper for babies, has no legs nor does the creeper body conform to the body section of plaintiff's design one-piece garment; while Ex. "O" is a boy's wash suit, which in no manner conforms to the said design garment.

Even with Exs. "M" and "O" before him, Mr. Kuh was unable to produce the defendant one-piece design play garment, Plaintiff's Ex. 5, but was required to call to his aid an expert, Miss Henrietta Loeb, and with the former infringing garment Ex. 4 before them and with full knowledge of the one-piece design play suit of the patent in suit, they proceeded to outline the so-called new garment, Plaintiff's Ex. 5. This is best outlined by the testimony of Miss Loeb, buyer for the Emporium of this city, having charge of one of its downstairs departments handling infants' wear and muslin underwear. Her testimony (Record p. 123) is:

"Mr. Kuh 'phoned to me one day and said, 'Miss Loeb, we are going to make up and bring out a new garment, and I would like to see you in regard to it.' So I came down to the office, and he showed me two garments, these two garments right here.

Q. You mean the pink garment and the blue garment?

A. Yes, one was a creeper and the other was a boy's wash suit.

Q. Which is the creeper?

A. This one here.

Q. This one marked Exhibit "M" is what you call a creeper?

A. Yes.

Q. And the other one, which is marked Ex. "O," you call that a boy's wash suit?

A. A boy's wash suit.

Q. Proceed.

A. So he showed me the two garments, and he said he thought he could combine the two, and I said, 'That is a very splendid idea, if you do, just change your yoke and make it round and put a belt in front; I suggested that, and the garment was shown me a few days later—a sample was shown me a few days later, and I just suggested

making it round here, instead of square, and having the belt come across the front, to make a decided girls' garment."

It will be noted that the idea of making an effort to combine two garments by taking the upper portion of one garment and the lower portion of the other garment so as to produce a one-piece garment did not occur to Mr. Kuh until after he had received notice of infringement from the patentee of the letters patent in suit by reason of the first one-piece design play suit Ex. 4 which the defendant had been placing upon the market and not then until after he had agreed to discontinue the infringement on being accorded permission by the patentees to dispose of the number of such garments which the defendant then had on hand. It is obvious that merely cutting away the lower portion of the child's creeper romper Ex. "M" and the upper portion of the boy's wash suit Ex. "O" and sewing together the respective upper and lower sections of the two garments, would not and did not produce the one-piece play suit design invention of the letters patent in suit; other steps were necessary to produce the said designed garment as it appears and illustrated by the so-called new garment, Plaintiff's Ex. 5, as disclosed by the testimony of Miss Loeb. Something in addition to the mere sewing together of the lower severed portion of Ex. "O" and the upper severed portion of Ex. "N" was required in order to produce the one-piece play suit, Plaintiff's Ex. 5, manufactured and placed on the market by the defendant, and these steps or changes required and resorted to were so done in order to produce the one-piece design play suit

invention of the plaintiff. It is exceedingly questionable to our mind whether or not Mr. Kuh or the defendant would have been able to produce the garment, Plaintiff's Ex. 5, had it not been for the fact that he utilized the expert knowledge of Miss Loeb. The expression "*that is a splendid idea*" given utterance to by Miss Loeb when Mr. Kuh explained what he wished to do, is significant and certainly is expressive in the highest degree that if the suggested idea could be carried out there would be produced a *new and attractive design one-piece garment* over the design garments of Ex. "M" and Ex. "O," and such "*splendid idea*" was expressed in the garment as ultimately produced having embodied therein the design invention one-piece play suit of plaintiff's Design Letters Patent No. 56,450, and with which the defendant was thoroughly familiar. The produced garment is in appearance and impression the said patented one-piece design garment. The application of the red strips to the front and back of the garment does not make it any less the design garment of the letters patent in suit, nor did the removal of the patch pockets from the front exterior of the garment to the front interior thereof take the same from within the design invention of the letters patent. Such slight variations of the garment, Plaintiff's Ex. 5, from the design one-piece play suit of the letters patent are mere equivalents and do not differentiate the said garment from the design invention of said letters patent to such an extent as to preclude or prevent an ordinary observer from purchasing the said garment believing he was purchasing the design garment of the letters patent. They are

the same garments as to curvature, configuration, angularity, belt and ornamentation, so much so that an ordinary observer in purchasing one garment would be led to believe it was the other, and the resemblance of one to the other is so close as to deceive an ordinary observer and sufficiently alike to induce him to purchase one, supposing it to be the other.

We assert without hesitation that the defendant wilfully appropriated plaintiff's design invention, after agreeing to discontinue the manufacture and sale thereof on being given permission to dispose of the stock it had on hand of its first manufactured infringing garment. It now appears that such agreement was entered into by the defendant with a mental reservation, viz: We will discontinue the manufacture of the particular design garment complained of (Plaintiff's Ex. 4), but shall immediately proceed with the manufacture and sale of a so-called new garment (Plaintiff's Ex. 5) substantially the same as our former infringing garment as to shape, curvature, configuration, angularity and belt effect in order that our trade may not know the difference between the two garments, but will place upon the garment slight additional ornamentation. Our position then will be it is a new garment, although the trade will not differentiate the two garments.

Such actions should not be sanctioned by a Court of Equity. Any doubt as to infringement and validity of the letters patent in suit should under circumstances such as here presented, be resolved in favor of the plaintiff. In fact, the language of the Circuit Court of Appeals in the case of *West vs. Frank*, 149 Fed. 423,



is applicable to the present case and should be given full force and effect, viz:

“If there be a doubt as to whether the departures constitute invention, it should be resolved in favor of the patent, not only by reason of the presumption arising from the grant, but also because the patented construction was retained on account of the novelty of the design, notwithstanding certain objections resulting from its peculiar conformation, and, furthermore because of the evidence as to the much greater popularity of the new design, because of its attractive appearance, and, finally, because of the actual bodily imitation by the defendant of the exact patented construction, under circumstances which indicate an inequitable attempt to appropriate the benefit shown to have resulted from the harmonious arrangement and proportions of the patented design.”

## PUBLIC ACQUIESCENCE AND RECOGNITION.

In any given case where public acquiescence and recognition have been given to the invention of letters patent, we are safe in assuming that that which is produced under the letters patent differs from all things which preceded it and to such an extent as to give the stamp of approval thereto as to novelty, originality and ornamentality. Under the record as here presented, we find that the design garment of the letters patent in suit was first manufactured by the patentees Miller and Macowsky in the early portion of the year 1919, said parties being then engaged in this city in the manufacture of children's garments. The article was placed upon the market by Miller and Macowsky prior

to the filing of their application for Design Letters Patent No. 56,450 and during the pendency of the application the garment manufactured by Miller and Macowsky was first brought to the attention of defendant's witness, H. Garfinkel, who at that time was located in San Francisco and engaged in the manufacture of children's dresses. The garment appealed to defendant's witness Garfinkel as being new, novel, of merit and attractive to such an extent that he proceeded to manufacture and market the one-piece play suit, using the design garment of Miller and Macowsky as a sample to go by. According to the testimony of said witness Garfinkel, the one-piece play suit manufactured by him was a counterpart of Miller and Macowsky's one-piece design play suit and he placed the same upon the market under the name "Micky." The first sale of 24 dozen "Micky" play suit garments was made by him to E. J. Fiesel of San Francisco through his house manager, A. S. Lowenstein. At this time witness Garfinkel was conducting his business under the name of "California Art Works" in the City and County of San Francisco, California. In addition to selling to E. J. Fiesel the garment known as "Micky," Defendant's Ex. "A," witness Garfinkel testifies that he sold the garment to the Emporium and to other stores, but this one-piece play suit garment manufactured and sold by witness Garfinkel under the name "Micky" was the design invention of Miller and Macowsky, and on notification that the design garment was their invention, Mr. Garfinkel very promptly discontinued the manufacture thereof, stating in this connection when asked whether or not he



disclosed his "Micky" garment to Miller and Macowsky:

"No, Miller and Macowsky came up to the factory one day and Mr. Macowsky, I believe he made a kick, in fact, told me there was a patent pending and it would be advisable for me not to make them; and it was for that very reason I stopped making them a short time after, I did not want to get involved. If there was a patent applied for at that time I did not know." (Record p. 76.)

and in response to the first cross-question asked the witness (Record p. 75) he stated that the garment which he manufactured under the name "Micky" was copied from the play suit of Miller and Macowsky. The design garment of the letters patent in suit certainly appealed to the manufacturer Garfinkel as an article of merit and novelty, else he would not as soon as he saw the garment have undertaken to reproduce and market the same. The garment must have appealed to A. J. Fiesel, else he would not have purchased the garments so made by Garfinkel, and the same holds true as to the Emporium.

Eloesser-Heynemann Co., plaintiff-appellant, at the request of an Oakland house dealing in children's suits, turned its attention to the production of a one-piece play suit, mainly for girls, which would be attractive and unique in its appearance. The result of their efforts was the production of plaintiff's one-piece play suit Ex. 3. This garment met with the hearty approval of Whithorne and Swan, of Oakland, California, and plaintiff-appellant proceeded to manufacture the garment on orders from said Oakland house. Shortly after the manufacture and sale there-

of, Eloesser-Heynemann Co. was notified by Miller and Macowsky that the garment so manufactured and sold constituted an infringement of the design garment of Letters Patent No. 56,450 in suit and this resulted in Eloesser-Heynemann Co. first taking a license from the patentees, Miller and Macowsky, and later purchasing the letters patent outright. The design garment was new to the manufacturing house of Eloesser-Heynemann Co., and equally so to Whithorne and Swan, these being houses keeping abreast of the times and fully cognizant of the various types of garments placed upon the market by merchants generally, and, more particularly, by their competitors in business. At the time Eloesser-Heynemann Co. produced their one-piece play suit they were not aware of the design garment of Miller and Macowsky, due to the fact that the same was only manufactured at that time to a limited extent and only placed upon the market a short while prior to the designing of what they then believed to be a new and original garment. We thus have acquiescence on the part of Garfinkel and by Eloesser-Heynemann Co. as to the invention of the letters patent in suit and Mr. Eloesser testified, in response to a question whether the public generally gave recognition to the letters patent in suit as follows (Record p. 33) :

“There has been a good deal of acquiescence, Mr. Acker. There have been a number of large concerns that manufactured this garment at one time, and who, upon notification, have ceased manufacturing it.”

and further advised that no one at the present time,

other than the defendant-appellee, is manufacturing the infringing garment. As showing the popularity of the design garment, and the ready reception which it met by the public, it is only necessary to direct attention to the testimony of witness Eloesser in response to the question as to whether or not sales had increased from year to year, his testimony being (Record p. 40) as follows:

“In 1919 we sold 17,176 garments, in 1920 we sold 32,760 garments, in 1921 we sold 134,748 garments, and in 1922 we sold 176,640 garments” (a total of 361,324 within a period of approximately three years),

and when asked whether the plaintiff was required to increase its manufacturing plant to take care of orders (Record p. 41):

“We have made considerable increases in our plant which was not nearly adequate to take care of the additional and specially large increase from 1920, to 1921, which outran our capacity, and we spent considerable sums of money in enlarging our plant to take care of the additional demand and provide for future growth.”

From the foregoing we feel confident that public acquiescence and public recognition has been given to the letters patent in suit. Of the large class of manufacturers of children's garments doing business in San Francisco, California, we find defendant Kuh Bros. the only one continuing the infringing act, all others having ceased on notification and respecting the rights of the plaintiff herein under the design letters patent.

## LAW OF THE CASE.

We respectfully submit that since the decision of the United States Supreme Court in the case of *Gorham Mfg. Co. v. White*, 81 U. S. 731, the leading decision bearing on the question of design letters patent, the courts have uniformly held the test relative to infringement of design letters patent to be:

“Whether in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same; if the resemblance is such as to deceive such an observer, inducing him to purchase one, supposing it to be the other, the one first patented is infringed by the other.”

In *Untermeyer v. Freund et al.*, 37 Fed. 342, it was held by Judge Coxe:

“The policy which protects a design is akin to that which protects the works of an artist, a sculptor or a photographer by copyright. It requires but little invention, in the sense above referred to, to paint a pleasing picture, and yet the picture is protected, because it exhibits the personal characteristics of the artist, and because it is his. So with a design \* \* \* the advantage, slight though it be, which attends such enterprise, and a rival in business should not be permitted thus openly and defiantly to invade the territory of another.”

In *Bush & Lane Piano Co. v. Becker Bros.*, 209 Fed. 233, Judge Hazel held:

“It is true enough that a design patent must involve invention; but its validity is not negatived by combined features that were separately found in other articles of this class.

"To constitute infringement, it is not absolutely essential that the defendant's design for its piano should be a Chinese copy of complainant's; but, under the doctrine of *Gorham v. White*, 14 Wall. 511, 20 L. Ed. 731, infringement is complete if the defendant's piano imparts to the mind the same general idea of ornamentation and appearance as does complainant's design."

In line with the foregoing is the decision of the Circuit Court of Appeals for the Second Circuit in the case of *Mygatt et al. v. Schaffer*, 218 Fed. 827, the Court stating:

"A design patent necessarily must relate to subject matter comparatively trivial and the courts have looked with greater leniency upon design patents than patents for other inventions. The object of the law is to encourage those who have the industry and genius to originate objects which give pleasure through the sense of sight."

In *Ashley et al. v. Weeks-Numan Co.*, 220 Fed. 899, the Circuit Court of Appeals for the Second Circuit states:

"It is not a proper test to place the two inkstands side by side, to determine whether or not there are certain differences. On the contrary, the correct test is whether the ordinary observer, giving such attention as a purchaser usually gives, would purchase the defendant's inkstand believing it to be that of complainants; and in applying that test it is necessary to observe that the subject matter relates to form and configuration of which no one had ever seen the like prior to the patent in suit. \* \* \* It is true that the exact dimensions found in the complainants' inkstand are not found in the defendant's inkstand. It is also true that the exact configuration of the cover in the complainants' inkstand is not present in the ink-

stand of the defendant; it is also true that defendant makes its inkstand with a black composition cover only, while the complainants make theirs both with a glass and a black composition cover; and it is true that defendant makes a circular pin tray instead of a rectangular one, and forms its pen rack by a groove in the cover, as distinguished from the pen rack formed by the raised portions of the complainants' inkstand."

In the case of *Inflexible Co. v. Megibow*, 251 Fed. 924, Judge Rellstab, quoting from *Phoenix Knitting Works v. Bradley Knitting Co.*, 181 Fed. 163, states:

"A design is patentable, if it presents to the eye of the ordinary observer a different effect from anything that preceded it, and renders the article to which it is applied, pleasing, attractive, and popular, even if it is simple, and does not show a wide departure from other designs, or if it is a combination of old forms."

The Court continuing:

"The plaintiff's design fully meets this test. The presumption of invention that arises from the grant of the plaintiff's letters patent is not overcome by the evidence in this case, and there is nothing on the face of the design that would justify this court in declaring that it was not the product of the inventive faculty."

In *Zidell v. Dexter et al.*, 259 Fed. 582, the same being for infringement of design letters patent relating to child's garment, the Court appreciated that differences existing between the defendant's design and the design of the plaintiffs' for letters patent did not suffice to relieve the defendant from the charge of infringement, where such differences comprised features



added (as in the present case) by the defendant to the design of the plaintiff, stating:

“As to Ex. No. 6 (and which was the garment held to be an infringement): the only difference worthy of notice between the article patented and Ex. No. 6 is the absence of the square neck, the addition of a belt to cover the waistband, and the pockets in the flaring hips. Ex. No. 6 was evidently created in the shape in which it is for the very purpose of avoiding the patent, by having a neck in the shape of a heart, rather than a square neck. But the change in that regard is not substantial. The creator of Ex. No. 6 has added a belt to the garment, which cannot be done to avoid infringement. Ex. No. 6 embodies all the features of the patented article, and the addition of the belt is of no consequence. The pockets in the flaring hips may be both useful and ornamental to this design, but it is something added to the patented article. The Court is of the opinion that Ex. No. 6 infringes.”

In the present case, defendant makes the neck opening of the play suit round instead of square, such being the only distinction between the first manufactured infringing one-piece play garment Ex. 4 and the patented design play garment of the plaintiff. As to the second one-piece play garment, Ex. 5, we find the same change in the neck opening, that is to say, a round opening instead of a square opening, and there has been added to the garment the feature of a red strip, arranged in an irregular line on the front and back of the garment above the waistline, and the patch pockets are arranged in the flaring hips of the article. These differences do not create a different design garment and in no manner differentiate the article from

the invention of the design letters patent in suit, for the same appearance is presented to the eye of the purchasing public.

The validity of the Zidell patent in the mentioned case was sustained on appeal from the decision of Judge Trippett, the case being reported 262 Fed. 145, this Court holding:

“The differences in designs, which under the patent law will avoid infringement, are differences which will attract the attention of the ordinary observer, giving such attention as the purchaser usually gives in buying articles of the kind in question and for the purposes for which they are intended.”

In the case of *Faris et al. v. Patsy Frock & Romper Co.*, 273 Fed. 900, decided by this Court June 6th, 1921, two design letters patent were presented, one being a design for an ornamented child's romper and the other being a non-ornamented child's romper. The second letters patent, or the one for the unornamented child's romper, were held invalid in view of the previously issued letters patent to the same inventor for the ornamented child's romper, on the ground that to make the ornamented design one would be required to make the unornamented design and such would constitute infringement of the then existing design letters patent for the non-ornamental child's romper, thereby holding that it was the design of the garment itself which determined the question of infringement and not the manner in which the ornamentation was applied to the garment.

In *Knappp v. Will & Baumer Co.*, 253 Fed. 191,

District Court of New York, Judge Ray held, citing with approval from the case of *Grelle v. City of Eugene, Oregon*, 221 Fed. 68:

"That each separate element in a patented design was old does not negative invention, which may reside in the manner in which they are assembled."

This was a case relating to a design letters patent for the design of candles and in commenting on the act of the defendant the Court stated:

"It is not the case of 'a Chinese copy,' but still complainant had a new and a novel design, pleasing to the eye, and defendant has copied it, with the changes mentioned, leaving the same general impression on the beholder who sees the two. The resemblance is such as to deceive the ordinary observer and purchaser,"

further stating:

"Defendant says the complainant's candle belongs to the 'Mission' age or period in candle making, and that defendant's candle belongs to the 'Colonial' style or period in the same art; that the one is distinctive and clearly distinguishable in structure and appearance from the other. This I cannot see. The slight change in the shape of the bell-shaped top has no substantial effect on the general appearance. The defendant has a patent for its design. This is evidence of a possible improvement in design clearly. To it I have called attention. But I think it well settled that, if a defendant appropriates an invention, be it a mechanical apparatus or a design, for which a patent has been granted, and improves upon it and obtains a patent, his patent covers his improvement, to which improvement he has the sole and exclusive right; but this subsequent patent does not impair

the rights of the prior patentee, nor does it confer on such subsequent patentee any right to use or appropriate it, and to use or make it in connection with his improvement, he infringes. In short, a valid patented invention is in no way annihilated or impaired by an improvement thereon by another and duly patented, and which improvement, in order to be of use, necessarily must be used with the invention of such prior patent. A valid pioneer invention, or an improvement thereon, may be improved upon as matter of course, and the improvement may be patented if it discloses patentable invention; but the improver cannot avail himself of the prior invention and appropriate it, in order to make his patented improvement available. If he does, he is liable as an infringer. *Cantrell v. Wallick*, 117 U. S. 689, 6 Sup. Ct. 970, 29 L. Ed. 1017."

In *Sampson v. Silverman et al.*, 275 Fed. 123, the Court states:

"In dealing with patents for design we must bear in mind that simplicity of line is often more desirable than ornate treatment, and that the evidence afforded by public acceptance of a design is entitled to special weight. Those who manufacture articles of ornament appealing to the public, and who adduce evidence showing a high degree of public satisfaction with the design and who also adduce evidence from other manufacturers of their acceptance of the design and their application for licenses to manufacture, may invoke the doctrine that the presumption of validity is to have weight with a court, especially against an infringer, who, by copying the design, had added his own evidence to its value and utility."

The contention by an infringer that the device which he infringes constituted no advance in the art is

not received with favor. *Lehnbeuter v. Holthaus*, 105 U. S. 94, 95, 96, 97, 26 L. Ed. 939 (a design patent); *Westinghouse Co. v. Wagner Mfg. Co.*, 225 U. S. 604, 616, 32 Sup. Ct. 691, 56 L. Ed. 1222, 41 L. R. A. (N. S.); *Aurora Mantle & Lamp Co. v. Kaufman*, 243 Fed. 911, 914, 156 C. C. A. 423.

Commenting relative to the law as expressed by the United States Supreme Court in *Gorham v. White*, supra, and followed by the cases herein cited, counsel for defendant-appellee announced to the lower court that said case had no application here—due to the fact that the decision was based upon the Act of March 2, 1861, stating said act had long since been repealed. The test, as applied in *Gorham v. White*, for determining the question of infringement regarding design inventions, applies with full force today irrespective as to the amendment of the Act of 1861. In fact, this Court relied in the main upon the case of *Gorham v. White* in connection with the Zidell design letters patent. The section of the Revised Statutes governing design inventions does, as counsel states, and as we have heretofore pointed out, sanction the grant of design letters patent for “any new, original and ornamental design for an article of manufacture.” It was for these features the design letters patent here involved were granted, and “*oddity, quaintness, simple artistic merit, attractiveness, popularity, and wide use*” has been found by the lower court in favor of the design invention of the letters patent in suit. Here the design invention of the letters patent involved comprises a one-piece play suit garment article of manufacture falling within the expression of this Court as

announced in the case of *Farris v. Patsy*, 273 Fed. 903, for that which design letters patent can issue, inasmuch as it is the shape, configuration, or outline given to the garment which produces the ornamental design thereof. To the design garment thus produced the inventors added certain ornamentation, viz., the color trimmings around the neck opening, at the ends of the short sleeves, and applied the belt effect disclosed by the drawings of the letters patent. However, we find the defendant-appellee's design of garment produced by following substantially the same shape, configuration, or outline, as that of the design letters patent and to such design garment the same color ornamentation applied. It is the same garment under the test for identity as expressed by the Supreme Court in *Gorham v. White* and later by this Court in construing the Zidell design letters patent.

On argument and in the points and authorities filed with the lower court, counsel for defendant contended the design letters patent were invalid because the design thereof resided in one portion of Defendant's Ex. "M" having applied thereto another portion of Defendant's Ex. "O" and in support of this position directed attention to the decision of the United States Supreme Court in the case of *Smith v. Whitman Saddle Co.*, 148 U. S. 679, stating that the therein claimed design invention resided in bringing together the front half of one saddle and the rear half of another saddle and that such did not create design invention. From this he argued that plaintiff-appellant's design of garment did not constitute invention as it comprised the mere union of one section of De-



defendant's Ex. "M" with another section of Defendant's Ex. "O." The answer to this is found (a) in the fact that in the case of *Smith v. Whitman Saddle Co.* the Supreme Court did not declare the design letters patent invalid, and (b) that the mere bringing together of the two sections of the mentioned garment exhibits does not produce the design invention of the letters patent in suit.

Counsel further directed the attention of the lower court to the file wrapper proceedings of design letters patent No. 56,450, stating that in the Patent Office the applicants limited their invention to certain details, and did not claim a broad or generic invention. Such is not a correct statement. While in the Patent Office the applicants specified certain existing differences in their design garment over the prior art cited, but did not deem it necessary to mention all the differences because the prior art did not anticipate their design invention.

Since the issuance of the design letters patent no effort has been made to expand the invention nor to claim more therefor than covered by the grant thereof. Such is unnecessary, inasmuch as the defendant's one-piece play suit—Plaintiff's Ex. 5—is the plaintiff's design invention one-piece play garment of the letters patent in suit. The differences pointed out in the Patent Office to partly distinguish the patentee's invention in certain respects from the cited prior art, are found embodied substantially in the defendant's claimed infringing garment, at least they are embodied therein to such an extent that the resemblance to the patented design garment is such "*as to deceive an*

*ordinary observer, inducing him to purchase one, supposing it to be the other."* This being so, the plaintiff's patented design one-piece play garment is infringed by the defendant's one-piece play garment—Plaintiff's Ex. 5.

In contending infringement on behalf of the defendant, as above set forth, and in view of the decision of the lower court that "Defendant's garment in entirety is plaintiff's in appearance and impression," we are not unmindful of the concluding portion of the court's decision, wherein after disposing of the question relative to the validity of the letters patent in suit and commenting as to whether defendant's garment would infringe, the statement is made, "We have to observe that in proper application of the rule of *Zidell v. Dexter*, *supra*, it would not infringe." Of course, this remark of the court is mere *obiter dictum* and perhaps need not be commented upon, but we are frank to state as to our inability to follow the line of reasoning of the court as so expressed relative to the case of *Zidell v. Dexter*. As we read said decision, it points out that in a case of this character infringement would exist. It is true in said case, this Court pointed out the differences existing between Ex. 4 and the design letters patent there involved and where said exhibit differentiated from the design garment of the letters patent, it appearing that the claimed infringing garment did not have embodied therein the ornamental stitching on the collar and cuffs of the patented design garment and furthermore, it contained no belt with buttons and it also distinctly differed from the design garment in the shape of its trousers, and further

pointed out that Ex. 5 possessed all the features of the design patent, except that it was not a single-piece garment and had no ornamental stitching; and as to Ex. 8, involved in the case, the Court held that it was similar to Ex. 4, except that it had no buttons on the belt. In other words, Ex. 8 differed from the letters patent there involved to the same extent that Ex. 4 differed from the patented design garment and in addition thereto further differed to the extent that it had no buttons upon the belt. In the present case, however, the defendant's one-piece play suit garment embodies all the features disclosed by the design one-piece play suit garment invention of the letters patent in suit, additional ornamentation being applied thereto.

Seemingly, counsel for the defendant seeks to take some advantage by pointing out to the Court that defendant has acquired the grant of letters patent for its design garment, said letters patent appearing as Defendant's Ex. Design Letters Patent No. 60,958 of May 16, 1922. The grant of design letters patent to the defendant does not in the carrying out thereof give to the defendant-appellee the right to infringe upon the previously issued design letters patent granted to the predecessor in interest of the plaintiff-appellant herein. In short, provided the letters patent herein involved are valid, the same are in no way annihilated or impaired by an improvement thereon by another and duly patented, and which improvement, in order to be of use, necessarily must be used with the invention of such prior patent. As well known, an improver cannot avail himself of a prior invention and appro-

priate it in order to make his patented improvement available and of use to himself, without the consent of the prior inventor. If he does so, he is liable as an infringer. *Cantrell v. Wallick*, 117 U. S. 689.

As we read the decision of this Court in *Zidell v. Dexter*, supra, a strict adherence to the reasoning set forth therein carries infringement in the present case, rather than non-infringement.

### CONCLUSION.

1. We submit that the errors on appeal are well founded in law and should be granted.

2. That the design invention of the letters patent in suit due to the oddity, quaintness, simple artistic merit, attractiveness, popularity and wide use of the design garment embodied therein, discloses invention over the prior art.

3. That the invention of the design letters patent in suit differs from the publication and the prior art letters patent set up as anticipation thereof, to such an extent as to warrant the finding of non-anticipation.

4. That the decision of the lower court is contrary to the law governing design inventions, not in accordance with equity and good conscience, nor in accordance with the facts of the case, and should be reversed.

Respectfully submitted,

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